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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/225,537	01/04/99	GINSBERG	P 1453-001C

EXAMINER	
AKERS,G	
ART UNIT	**PAPER NUMBER**
2765	3

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DATE MAILED: 01/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/225,537	Applicant(s) Ginsberg
	Examiner Geoffrey Akers	Group Art Unit 2765

☒ Responsive to communication(s) filed on *Jan 4, 1999* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-16* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-16* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). [illegible]

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Claims 1-16 have been examined. Applicant is requested to resubmit this document. The IDS submitted October 4, 1999 was misplaced from the file.

Specification

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract is objected to because abstract should be a single paragraph.

Claim Rejections - 35 USC § 101

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 5857176 (Ginsberg). This is a double patenting rejection.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,774,880(Ginsberg). Although the conflicting claims are not identical, they are not patentably distinct from each other because the recitation of a communications means would have been obvious in that one would seek the results of the computations.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-16 are rejected under 35 U. S. C. 101 as being directed to an abstract idea(or merely solving a mathematical problem) without limitation to a practical application.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 and 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.The language "in combination" suggests a union of systems but all that is claimed is a single unit.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Towers et al(US Pat. No. 4,566,066).

14. As per claim 12, Towers (US Pat. 4566066)l teaches a system for processing disparate price data on fixed income securities in real time(col 3 line 35-col 5 line 17). Official notice is taken that the calculation of indeces, quality factors and the like is an old and well known method in the art at the time of this invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to do so. The motivation for doing such is that an index is a convenient measurement for the performance of a security.

15. As per claim 13, Towers et al. teach a method wherein said means to provide an index value includes data collection means for receiving data on a proper set of securities associated with the closing price of said securities as expressed by an established securities market.(col 3 line 50-col 4 line 16).

16. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Towers(US Pat. No. 4,566,066) and Tull Jr. (US Patent No. 5,946,667).

17. As per claim 14, Towers et al teach a method wherein said data colllection means include a means for receiving data corresponding to market activity at one or more markets(col 3 line 50-col 4 line 16). Towers fails to teach receiving data in real time, but rather on a daily basis. Tull et al teach receiving data in real time using financial debt instruments as the underlying asset class(col 8 lines 36-46) .Official notice is taken that the reception of data in real time is an old and well known method and existed at the time of this invention. It would have been obvious to one of ordinary skill in the art. The motivation to combine Tull and Towers is that real time data in securities values is a more accurate representation of the instrument's performance.

18. As per claim 15, Towers teaches a method of securities valuation for financial debt instruments directly including Treasuries(col 9, col 11,col 13,col 15). Tull teaches a method of real time valuation of debt securities(col 8 lines 36-46). Towers in view of Tull teach a method of real time valuation of Treasuries of any arbitrary duration. The motivation to combine Tull with Towers is that real time data in securities values is a more accurate representation of the instrument's performance.

19. As per claim 16, Towers teaches a method of securities valuation for financial debt instruments directly including Treasuries(cols 9, 11,13,15). Tull teaches a real time valuation of debt securities(col 8 lines 36-46). Towers in view of Tull teach a method of real time valuation of Treasuries of any arbitrary duration which may be sorted by least expensive to deliver on a pre-selected date. The motivation to combine Towers in view of Tull is that real time data in securities values is a more accurate representation of a securities performance and sorting by price is a convenient representation.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Luskin et al teach an improved method for managing assets in one or more asset classes including debt instruments.

-Michaud et al teach a method for evaluating an existing or putative portfolio having a plurality of assets including bonds

-Nevo et al teach an apparatus and method for monitoring financial securities markets or financial secutities to provide information regarding the status of the markets or securities

-Weiss et al teach a system for the management and implementation of a new form of swecuyrity which provides risk managment capabilities without the complexities associated with other types of risk managment vehicles

-Keiser et al teach a method for a computer inplemented financial managment system that ;permits the trading of securities via a network

-Roberts et al teach a method to fund a future liability of uncertain value and the defeasance of its future cost

Any questions regarding this communication should be addressed to Dr. Geoffrey Akers whose telephone number is (703) 306-5844. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

GRA

Janmuary 20, 2000

ERIC W. STAMBER
PRIMARY EXAMINER